

### REMARKS/ARGUMENTS

#### I. Status of the Claims

Claims are currently pending, with claims 4, 10, 13-21, 43, 51-53 and 55-126 withdrawn from consideration as directed to non-elected inventions. Upon entry of this amendment, claim 1 is amended and claim 39 canceled without prejudice or disclaimer. Applicants reserve the right to reintroduce the unamended or canceled claims in this or another application. New claim 127 is introduced upon entry of this amendment. Claims 1-127 are thus pending following entry of this amendment, with claims 4, 10, 13-21, 43, 51-53 and 55-126 withdrawn from consideration.

The amended and new claims are supported throughout the specification, including, for example, the following sections:

Claim 1: page 6, lines 15-22; page 16, lines 25-27; and page 25, line 25 to page 26, line 28.

Claim 127: original claim 39; and paragraph bridging pages 18 and 19.

#### II. Election and Restriction

Although they are within the elected group, it is noted that claims 4, 10, 13-21, 43 and 51-53 are nonetheless considered to be withdrawn because they are directed to non-elected species. It is Applicants' understanding that pursuant to MPEP 809.02(c) that these claims will be reinstated once a generic claim is found allowable.

#### III. Claim Rejections under 35 U.S.C. §112, Second Paragraph

Claims 1-3, 5-9, 11-12, 22-42, 44-50 and 54 are rejected under 35 U.S.C. 112, second paragraph as indefinite.

Claim 1 is said to be indefinite because the phrase "displaying a compound other than an expressed polypeptide" is said to be unclear. The claim has been amended as suggested by the Examiner to clarify that the compound is other than a polypeptide expressed by the replicable genetic package.

Claim 1 is also said to be indefinite because the phrase "wherein the replicable genetic package comprises a nucleic acid tag encoding a characteristic of the compound" is unclear. To provide greater clarity, the claim has been amended to recite that the replicable

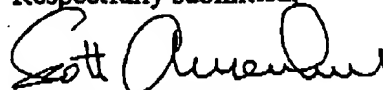
genetic package comprises a heterologous nucleic acid tag that can be decoded to identify a characteristic of the compound.

Claim 39 is said be unclear because it is unclear how a single replicable genetic package can refer to a collection of replicable genetic packages. As suggested by the Examiner, this claim has been rewritten as an independent claim, namely new claim 127.

These claim amendments simply make explicit what was previously implicit and make the language consistent with language in the specification. These amendments do not narrow the scope of the claims in any way. The amended claims are thus entitled to the full scope of equivalents to which the original claims were entitled.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Scott L. Ausenhus  
Reg. No. 42,271

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
SLA:md  
60026615 v1